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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,433

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EXAMINER

MAI, HAO D

ART UNIT

PAPER NUMBER

3732

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DELIVERY MODE

05/07/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,433	<b>Applicant(s)</b> TANIMURA, REMY	
	<b>Examiner</b> HAO D. MAI	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-20, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 18-20 and 24 is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-17, 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

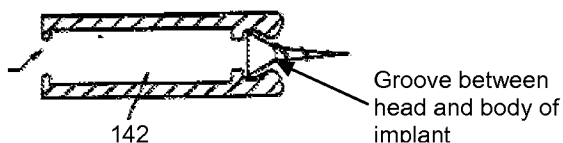
### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 2-3, 5, 7, and 13-16, are rejected under 35 U.S.C. 102(b) as being anticipated by Gambale (6,328,746 B1).**

Regarding claim 2, Gambale discloses a system capable of reversible fixing of a tool to an end of an implantable element, when fitting a dental prosthesis, the system comprising: at least one tool 20; at least one implantable element/screw 17; and at least one hollow intermediate connecting part 100 (Fig. 2a-2b). The intermediate connecting part 100 comprises: a first clip 142 capable of reversibly fixing an external complementary part of the tool thereon and preventing longitudinal movement of the tool relative to itself (Figs. 3-4;; column 5 lines 64-67); and a second clip capable of clipping onto a complementary part of the implantable element 17 so as to enable reversible fixing of the tool to and in direct contact with said implantable element. The implantable element 17 has a head, a body, and a groove (between the top of the head and first thread from the head; see annotated Figure below) positioned axially there between; the body is configured to extend axially from the groove and into the patient's body. The hollow intermediate connecting part 100 is configured to be received by the groove of the implantable element; and capable of contacting said groove at an edge of hollow intermediate connecting part that is axially closest to the body of the implantable element as shown in Fig. 3.



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As to claims 3, the first clip 142 is shown to comprise at least one groove formed in an internal wall of the hollow intermediate connecting part and capable of cooperate by clipping with a salient peripheral rib on the tool. Note that the shaft of tool 20 where being inserted into the hollow intermediate part 100 is interpreted to be equivalent to the recited limitation "salient peripheral rib on the tool". Also note that the recitation "...designed to cooperate by clipping with a salient peripheral rib on the tool" is functional language and does not convey any positive structural limitation in an apparatus claim. As to claims 5, note the second groove that receives the implant's head.

As to claims 7 and 13-14, the hollow intermediate connecting part 100 is disclosed be made out of plastic (column 3 lines 20-25); and include an opening (inner bore) passing through the surface at both ends for receiving the tool and the implantable element, and spigots (i.e. annual lips 133 and other annual lips in Figure 3) that are salient towards the inside of the connecting part 100. As to claims 15-16, screw 17 is capable of being a dental implant and screw driver tool 20 is capable of being a placing tool.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 2-5, 7-17, and 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gervais et al. (7,160,109 B2).**

Regarding claim 2, Gervais et al. disclose a system for reversible fixing of a tool to an end of an implantable element, when fitting a dental prosthesis, the system comprising: at least

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one tool 18; at least one implantable element 16/12; and at least one hollow intermediate connecting part/fixture mount 14 (Fig. 1). The intermediate connecting part 14 comprises: a first clip 15 capable of reversibly fixing an external complementary part of the tool thereon and preventing longitudinal movement of the tool relative to itself; and a second clip 51 clipping the implantable device 16/12 (Fig. 1; column 6 lines 47-50). As to the newly recited limitations, the implantable element 16/12 has a head 17, a body 16/12, and a groove (between undersurface 51 and shoulder 31) positioned axially there between; the body is configured to extend axially from the groove and capable of extending into the patient's body. The hollow intermediate connecting part 14 is configured to be received by the groove of the implantable element and further configured to contact the groove of the implantable element at an edge of hollow intermediate connecting part that is axially closest to the body of the implantable element.

However, Gervais et al. fail to disclose the tool being in direct contact with the implantable device. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gervais et al. by having the tool in direct contact with the implant while they are reversibly fixed together. Such modification is merely a design choice of rearrangement of part (moving the tool further into the hollow connecting part so that the tool in touches the implant) that is well within the skill of an artisan. *MPEP* § 2144.04. Such direct contact between the tool and the implant does not necessarily impart additional torque from the tool to the implant; and thus would not defeat the purpose of the fixture mount to limit the torque applied to the implant.

As to claims 3-4, the first clip 15 comprises at least one groove (between 15 and upper surface 51) formed in the an internal wall of the hollow intermediate connecting part and designed to cooperate by clipping with a salient peripheral rib 20 on the tool 18; wherein said groove is delimited by at least one rim 51 being designed to cooperate by clipping with the

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groove formed at the end of the implantable implant. As to claim 5, note the second groove (best pointed to by reference numeral 28 or 23a in Figure 1) formed in the internal wall and configured to cooperate with an external rib formed at the end of the implant.

As to claims 7-12, the hollow intermediate connecting part 14 is further disclosed to be made of plastic and/or metal (column 16 lines 31-34), and comprising paralleling slots/openings 148 allowing the hollow intermediate connecting part 14 to be deformable (Fig. 10; column 3 lines 50-56; column 13 lines 1-10). These slots are shown in alternative embodiments to be T-shaped slots 120 (Fig. 8) or oblique slots 138 (Fig. 9). As to claim 13-14, note the bore/opening 52 being parallel to the longitudinal axis (Fig. 6); and the spigots/splines 64 being salient towards the inside of the hollow intermediate connecting part 14 (Fig. 2). As to claims 15-17, the implantable element 16/12 is disclosed to be a dental implant 12; the drive tool 18 is capable of placing the implantable element; the drive tool 18 is also capable of being a transfer part (column 11 lines 31-34). As to claim 25, the radial width (diameter) of the head 17 is shown to be smaller than that of the body 12 of the implantable element.

#### ***Allowable Subject Matter***

5. Claims 1, 18-20, and 24, are allowed.

#### ***Response to Arguments***

6. Applicant's amendments to the method claims 1, 18-20, and 24, have overcome Lederer and put the claims in allowable condition. The amendments reciting new structural limitations to the apparatus claims 2 however fail to overcome Gambale and Gervais. Applicant's remarks regarding the newly recited limitations with respect to Gambale and Gervais are held to be responded to in the rejection above.

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***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Hao D Mai/  
Examiner, Art Unit 3732**

**/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732**